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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,956	07/16/2003	Jeremy E. Dahl	005950-834	2018
7590 09/28/2005			EXAMINER	
BURNS, DOANE, SWECKER & MATHIS, L.L.P.			HASAN, MOHAMMED A	
P.O. Box 1404			ART UNIT	
Alexandria, VA 22313-1404			PAPER NUMBER	
			2873	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8/2

Office Action Summary	Application No.	Applicant(s)	
	10/621,956	DAHL ET AL.	
	Examiner	Art Unit	
	Mohammed Hasan	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 70 is/are pending in the application.
 4a) Of the above claim(s) 4- 57, 62 - 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3, 58 - 61 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/05, 1/3/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 1-3, 58 – 61 are drawn to lens in the reply filed on 8/5/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 4 – 57, 62 – 70 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement filed on 8/5/2005.

Oath/Declaration

3. Oath and declaration filed on 7/16/2003 is accepted.

Information Disclosure Statement

4. The prior art documents submitted by applicant in the Information Disclosure Statement filed on 5/25/2005, 1/3/2005, 11/23/2004, and 7/15/2004 have all been considered and made of record (note the attached copy of form PTO – 1449).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 3, and 58 – 61 are rejected under 35 U.S.C.102 (b) as being anticipated by Kirkpatrick (5,082,359).

Regarding claim 1, Kirkpatrick discloses (refer to figure 4) an optical comprising a diamondoid-containing material (28) (column 8, lines 27 – 21).

Regarding claim 2, Kirkpatrick discloses, wherein the diamondoid-containing material comprises at least one higher diamondoid (column 3, lines 46 – 53).

Regarding claim 3, Kirkpatrick discloses, wherein the at least one higher diamondoid is a derivatized higher diamondoid (column 3, lines 46 – 53).

Regarding claim 58, Kirkpatrick discloses, wherein the optical device is selected from the group consisting of a lens (column 7, line 38) .

Regarding claim 59, Kirkpatrick discloses , wherein the diamondoid-containing material is selected from the group consisting of a CVD- deposited film, a molecular crystal (column 6, lines 51 – 55, i.e., crystal 32, column 8, lie 17).

Regarding claim 60, Kirkpatrick discloses, wherein the diamondoid-containing material comprises at least heterodiamondoid derivatives therof (column 4, lines 20 – 24).

Regarding claim 61, Kirkpatrick, wherein the diamondoid-containing material comprises at least heterodiamondoid derivatives therof (column 4, lines 20 – 24).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The closest prior art

Bailey et al (5,470,661) discloses, a diamond-like carbon films from hydrocarbon helium plasma.


Plano et al (5,432,003) discloses, a continuous thin diamond film and method for making same.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammed Hasan whose telephone number is (571) 272-2331. The examiner can normally be reached on M-TH, 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571) 272- 2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MH
September 20, 2005



Scott J. Sugarman
Primary Examiner